



Paper No. 4

NUTTER MCCLENNEN & FISH LLP  
ONE INTERNATIONAL PLACE  
BOSTON, MA 02110

**COPY MAILED**

**NOV 15 2001**

**OFFICE OF PETITIONS**

|                                 |   |                     |
|---------------------------------|---|---------------------|
| In re Application of            | : |                     |
| Everdell et al.                 | : |                     |
| Application No. 09/838,320      | : | DECISION DISMISSING |
| Filed: 19 April, 2001           | : | PETITION            |
| Attorney's Docket No. 102689-86 | : |                     |

This is a decision on the petition filed on 17 September, 2001, to accord the above-identified application a filing date of 19 April, 2001, with three (3) sheets of drawings containing Figures 34b, 59, and 60n described in the specification as a part of the original disclosure.

The instant application was filed on 19 April, 2001. On 16 July, 2001, Initial Patent Examination Division mailed a "Notice of Omitted Item(s) in a Nonprovisional Application" stating that the application had been accorded a filing date of 19 April, 2001, but that Figures 34b, 59, and 60n described in the specification appeared to have been omitted. The Notice set a two month period for reply from the 16 July, 2001, mailing date.

In response to the Notices, petitioners timely filed the present petition on 17 September, 2001, accompanied by three (3) sheets of drawings containing Figures 34b, 59, and 60n. Petitioners assert that the three sheets of drawings are entitled to a filing date of 19 April, 2001, because they do not contain new matter and because the present application claims priority to Application No. 09/703,856, which includes Figures 34b, 59, and 60n.

The evidence is not persuasive. The record does not adequately show that the sheets of drawings were received at the USPTO on 19 April, 2001. It is noted that the USPTO has a long-established and well publicized practice for *prima facie* establishing the

date of receipt of correspondence that has either been mailed or otherwise delivered to the PTO, and is asserted to have been subsequently misplaced: the itemized postcard receipt practice of MPEP 503.<sup>1</sup> This practice requires that any paper(s) for which a receipt is desired be filed in the USPTO with a self-addressed postcard identifying the paper(s). A postcard receipt which itemizes and properly identifies the paper(s) which is being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. However, due to the absence in the record of a postcard receipt itemized with respect to the drawings that bears a USPTO date stamp of 19 April, 2001, showing that three (3) sheets of drawings containing Figures 34b, 59, and 60n were received in the USPTO on 19 April, 2001, the application cannot be accorded a filing date of 19 April, 2001, with Figures 34b, 59, and 60n, as a part of the original disclosure.

Petitioners also state in the present petition that Figures 34b, 59, and 60n filed on 17 September, 2001, are substantially similar to Figures 34b, 59, and 60n of the drawings filed with prior application No. 09/703,856, the priority case for the instant application; however, the mere fact that the figures in the priority application may resemble the figures submitted on 17 September, 2001, is insufficient to accord a 19 April, 2001, filing date for the figures submitted 17 September, 2001. The mere reference to another application is not an incorporation of anything therein into the application containing such reference.<sup>2</sup>

In view of the above, the petition is **dismissed**.

This application has already been processed without the drawings filed on 17 September, 2001. The three (3) sheets of drawings containing Figures 34b, 59, and 60n filed on 17 September, 2001, will not be used for examination purposes, but will be retained in the application file.

Of course, petitioner may submit Figures 34b, 59, and 60n in the form of a preliminary amendment. If Figures 34b, 59, and 60n are

---

<sup>1</sup> The public was afforded a "reminder" of the then extent post card receipt practice at 857 *Off. Gaz. Pat. Off.* 667 (O.G.) (Nov. 21, 1968). This specific notice is usually repeated annually, in a January "Consolidated Listing" section of the O.G. that contains important O.G. notices of continuing relevance.

<sup>2</sup> In re Seversky, 177 USPQ 144, 146 (C.C.P.A. 1973) and Dart Industries, Inc. v. Banner, 207 USPQ 273, 276 (D.C. Cir. 1980).


submitted as a preliminary amendment, it will be reviewed by the examiner for new matter.

As the petition resulted from applicant's filing error and not as a result of an error on the part of the Office, the petition fee will not be refunded.

Any request for reconsideration of this petition must be submitted within **two months** of the mailing date of this decision in order to be considered timely. See 37 CFR 1.181(f). Extensions of time under 37 CFR 1.136(a) are not permissible.

The application file is being forwarded to the Office of Initial Patent Examination for further processing with a filing date of 19 April, 2001, using the application papers filed on that date. The copy of Figures 34b, 59, and 60n supplied with the present petition will not be processed or examined, but will be retained in the application file.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood, at (703)308-6918.



Beverly M. Flanagan  
Supervisory Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy